

REMARKS

Reconsideration of the Office action mailed August 1, 2005 is requested in view of the foregoing amendments and the following remarks.

Election/Restrictions

Applicant notes that claims 30-41 are withdrawn from consideration as being directed to a non-elected invention. Applicant requests that claims 30-39 be cancelled without prejudice. Applicant reserves the right to pursue these claims in a divisional or other application. Claims 40-41 remain in the application as withdrawn claims that depend from claim 1.

Special Circumstances

The Examiner asked applicant to point out any material information from co-pending applications listed as parents to the instant application if the criteria for materiality applies and if the examination record provides reason for applicant to believe that the Examiner has not considered such information. Applicant has previously identified applications and believes that identification satisfies the duty of disclosure. Applicant is also attaching an updated list of applications and patents to this document. The Examiner is requested to inform applicant if further information is needed.

Double Patenting

1. Application 10/251,576.

The Examiner provisionally rejected claim 1 under the judicially created doctrine of obviousness-type double patenting in light of claims 16 and 18-20 from co-pending application 10/251,576. That rejection is traversed because

claim 1 from the present application is patentably distinct from the cited co-pending claims. Nevertheless, applicant has abandoned the cited co-pending application in favor of a continuation application, and the continuation application does not include copies of claims 16 or 18-20 from application 10/251,576. Accordingly, this rejection is moot.

2. Application 09/955,418.

The Examiner provisionally rejected claim 1 under the judicially created doctrine of obviousness-type double patenting in light of claim 1 from co-pending application 09/955,418. That rejection is traversed. Nevertheless, the cited co-pending claim has been cancelled without prejudice so this rejection is moot.

3. Application 09/676,190.

The Examiner provisionally rejected claims 1, 5 and 10 under the judicially created doctrine of obviousness-type double patenting in light of claims 27, 29, 30, 37, 38, 39 and 40 from co-pending application 09/676,190. That rejection is traversed. Nevertheless, claim 10 from the present application has been cancelled without prejudice, so the rejection of that claim is moot. Concerning claims 1 and 5, those claims recite "a detection system adapted to detect contact between a person and the cutting tool." The cited co-pending claims do not, or have been amended so that they do not, include or disclose that limitation. Therefore, claims 1 and 5 in the present application cannot be obvious in light of the cited co-pending claims because all claim limitations must be disclosed or suggested by the cited claims in order to establish a *prima facie* case of obviousness. MPEP 2143.03.

4. US Patents 6,877,410 and 6,813,983.

The Examiner rejected claim 10 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-20 from US Patent 6,877,410 and claims 1, 4 and 11 from US Patent 6,813,983. Those rejections are traversed, but are now moot because claim 10 has been cancelled without prejudice.

5. Application 10/794,161.

The Examiner provisionally rejected claims 1, 5 and 10 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-19 from co-pending application 10/794,161. Claim 10 from the present application has been cancelled without prejudice so the rejection of that claim is moot. Concerning claims 1 and 5, that rejection is traversed because a two-way test for obviousness should have been applied.

A two-way test for obviousness should apply when considering whether the claims in an earlier-filed application are obvious in light of claims in a later-filed application. Section 804(II)(B)(1)(b) from the MPEP explains this rule in the context of a later-filed application that issues as a patent before an earlier-filed application:

[W]here, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office.

This rule is taken from the case of In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). In that case, the Board of Patent Appeals and

Interferences affirmed an obviousness-type double patenting rejection of an earlier-filed application in view of a commonly-assigned but later-filed patent. Both the application and the patent concerned optical record carriers such as CDs. The Board applied a one-way test for obviousness and determined that the claims at issue from the earlier-filed application were obvious in light of claims from the later-filed patent. The Federal Circuit reversed and explained that a two-way test should have been applied because the two applications could not have been filed together as one, because it was not applicant's fault that the later-filed application issued first, and because the later-filed claims were not obvious in light of the earlier-filed claims. *Id.* at 594, 19 USPQ2d at 1293. The court explained that the rationale behind the application of the two-way test "is that an applicant (or applicants), who files applications for basic and improvement patents should not be penalized by the rate of progress of the applications through the PTO, a matter over which the applicant does not have complete control." *Id.* at 593, 19 USPQ2d at 1292 (citing 3 D. Chisum, *Patents*, §9.03[2][c] (1990), and the following cases: *In re Borah*, 345 F.2d 1009, 148 USPQ 213 (CCPA 1966), *In re Stanley*, 214 F.2d 151, 102 USPQ 234 (CCPA 1954), *In re Calvert*, 97 F.2d 638, 38 USPQ 184 (CCPA 1938), *Thomson-Houston Elec. Co. v. Elmira & Horseheads Ry. Co.*, 71 F. 396 (2d Cir.), *cert. denied* 163 U.S. 685, 16 S.Ct. 1201, 41 L.Ed.2d 315 (1896), *Thomson-Houston Elec. Co. v. Ohio Brass Co.*, 80 F. 712 (6th Cir. 1897)).

The case of *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998), further explains when a two-way test applies. In *Berg*, the Federal Circuit

affirmed a one-way double patenting rejection of genus claims in light of nearly identical species claims. The claims concerned a method of preparing abrasive particles for use as an abrasive grit. The genus and species claims were the subject of two separate applications filed the same day. The species claims issued first and the Patent Office applied a one-way test to reject the genus claims in light of the species claims. The court affirmed the double patenting rejection and the application of the one-way test because Berg could have filed all the claims in a single application but instead chose to file two separate applications on the same day. Id. at 1433, 46 USPQ2d at 1230.

Even though Berg affirmed the application of the one-way test, the court recognized that the two-way test applies when a later-filed improvement patent issues before an earlier-filed basic invention. Specifically, the court distinguished Braat by saying: "Braat ... emphasized the more typical scenario in which, despite common inventive entities, the two-way test applied: 'when a later-filed improvement patent issues before an earlier filed basic invention.'" Id. at 1434, 46 USPQ2d at 1230 (quoting In re Braat, 937 F.2d at 593, 19 USPQ2d at 1292, emphasis added in Berg). The court in Berg also said the "essential concern" behind the two-way test "was to prevent rejections for obviousness-type double patenting when the applicants filed first for a basic invention and later for an improvement, but, through no fault of the applicants, the PTO decided the applications in reverse order of filing, rejecting the basic application although it would have been allowed if the applications had been decided in the order of their filing." Id. at 1432, 46 USPQ2d at 1229. These statements confirm that the

two-way test applies when a later-filed patent issues before an earlier-filed application through no fault of applicant.

The situation in the present application is the same as in Braat and as described in Berg, and therefore, the two-way test for obviousness should apply. The present application was filed well before the cited co-pending application and the cited co-pending application could not have been filed with the present application because it includes additional disclosure of later-developed material. Also, the cited claims from the later-filed application are not obvious in light of the earlier-filed claims.

The two-way test applies to an earlier filed application unless the applicant delays issuance of the earlier application until after issuance of the later-filed application. In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233. If applicant does not delay the issuance of the first application, then any delay is simply the result of the administrative process. The cases of Braat and Berg illustrate this point. In Braat the Federal Circuit applied the two-way test because it was "not [applicant's] fault that the combination claims in the [subsequent] patent issued first." Braat, 937 F.2d at 594, 19 USPQ2d at 1293. Applicant did not act to delay the issuance of the first application. In Berg the Federal Circuit did not decide whether there was delay, but gave the following examples of how an applicant could delay the issuance of a first-filed application: "filing the genus claims long after the species claims even though the two were invented at nearly the same time or the genus claims were invented first, or by filing numerous continuations in the genus application while failing to respond substantively to PTO Office

actions.” In re Berg, 140 F.3d at 1434 n.6, 46 USPQ2d at 1231 n.6 (citing In re Emert, 124 F.3d 1458, 1461, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997)).

The present application is similar to Braat because applicant has not acted to delay its issuance. The present application was filed first, more than 2 ½ years before the cited co-pending application. Also, the present application is not the result of multiple continuation applications, and applicant has responded substantively and promptly to each Office action. Thus, none of the acts identified in Berg by which an applicant may delay prosecution are found in the present application. These facts show that applicant has not delayed the issuance of the present application.

For all these reasons, a two-way obviousness test should be applied. Under that test, the present double patenting rejection is improper and should be withdrawn because the cited co-pending claims include limitations that distinguish and are not obvious over claims 1 and 5 in the present application.

Applicant also points out that the policy behind an obviousness-type double patenting rejection is “to prevent an unjustified extension of the term of the right to exclude granted by a patent by allowing a second patent claiming an obvious variant of the same invention to issue to the same owner later.” In re Berg, 140 F.3d at 1431-1432, 46 USPQ2d at 1229. This is not a concern in the present application because patent term is now measured from the filing date rather than the issue date. 35 USC 154(a)(2).

Applicant further points out that this double patenting rejection of earlier-filed claims is inconsistent with the practice of filing continuation-in-part

applications. The rejection, if correct, would mean that a subsequent invention comprising A, B and C could be the basis for a double patenting rejection of a previous invention comprising only A and B even though the subsequent invention could not have been included in the prior application because it had not yet been invented and even though the claims to the subsequent invention could not be added to the earlier application because those claims would constitute new matter. The result would be to unfairly limit the ability of an inventor to file applications on subsequent inventions, which is contrary to the ruling of Braat discussed above.

This double patenting rejection also results in unequal treatment under the patent laws. Specifically, this double patenting rejection prevents applicant from receiving separate patents to genus and species inventions simply because one application includes claims that dominate claims in the other application, even though others could obtain separate patents. For example, if a third party invented the machine described in the cited co-pending claims instead of applicant, then both applicant and the third party could patent their respective inventions without receiving a double patenting rejection even though the claims to the genus would dominate the claims to the species. If unrelated parties can file separate applications to genus and species claims without invoking a double patenting rejection, then a single party should be able to do likewise.

Allowable Subject Matter

The Examiner indicated that claims 19-24 are allowable.

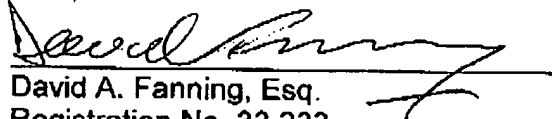
Concerning claims 1 and 5, there are no prior art rejections of those claims and the double patenting issues have been addressed. Therefore, claims 1 and 5 should also be allowed.

Applicant requests that withdrawn claims 40 and 41 be reinstated and allowed because they depend from claim 1.

Conclusion

For the reasons discussed herein, applicant submits that all of the issues raised in the Office action mailed August 10, 2005 have been addressed and overcome, and therefore, the application should be allowed.

Respectfully submitted,
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Attachment 1

<u>Title</u>	<u>Serial No./ Publication No./ Patent No.</u>	<u>Filing Date/ Publication Date/ Issue Date</u>
Detection System For Power Equipment	09/929,426 2002-0017176-A1	August 13, 2001 February 14, 2002
Contact Detection System For Power Equipment	60/225,200	August 14, 2000
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	09/929,221 2002-0017336-A1	August 13, 2001 February 14, 2002
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	60/225,211	August 14, 2000
Firing Subsystem For Use In A Fast-Acting Safety System	09/929,240 2002-0020263-A1	August 13, 2001 February 21, 2002
Firing Subsystem For Use In A Fast-Acting Safety System	60/225,056	August 14, 2000
Spring-Biased Brake Mechanism For Power Equipment	09/929,227 2002-0020271-A1	August 13, 2001 February 21, 2002
Spring-Biased Brake Mechanism For Power Equipment	60/225,170	August 14, 2000
Brake Mechanism For Power Equipment	09/929,241 2002-0017180-A1	August 13, 2001 February 14, 2002
Brake Mechanism For Power Equipment	60/225,169	August 14, 2000
Retraction System For Use In Power Equipment	09/929,242 2002-0017181-A1	August 13, 2001 February 14, 2002
Retraction System For Use In Power Equipment	60/225,089	August 14, 2000
Safety Methods For Use In Power Equipment	10/984,643 2005-0066784-A1	November 8, 2004 March 31, 2005
Replaceable Brake Mechanism For Power Equipment	09/929,236 2002-0020261-A1	August 13, 2001 February 21, 2002
Replaceable Brake Mechanism For Power Equipment	60/225,201	August 14, 2000
Brake Positioning System	09/929,244 2002-0017182-A1 6,857,345	August 13, 2001 February 14, 2002 February 22, 2005
Brake Positioning System	60/225,212	August 14, 2000
Brake Positioning System	11/061,162 2005-0139051-A1	February 18, 2005 June 30, 2005

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Serial No. 09/929,242

<u>Title</u>	<u>Serial No./ Publication No./ Patent No.</u>	<u>Filing Date/ Publication Date/ Issue Date</u>
Logic Control For Fast-Acting Safety System	09/929,237 2002-0020262-A1	August 13, 2001 February 21, 2002
Logic Control For Fast-Acting Safety System	60/225,059	August 14, 2000
Motion Detecting System For Use In A Safety System For Power Equipment	09/929,234 2002-0017178-A1	August 13, 2001 February 14, 2002
Motion Detecting System For Use In A Safety System For Power Equipment	60/225,094	August 14, 2000
Translation Stop For Use In Power Equipment	09/929,425 2002-0017175-A1	August 13, 2001 February 14, 2002
Translation Stop For Use In Power Equipment	60/225,210	August 14, 2000
Translation Stop For Use In Power Equipment	60/233,459	September 18, 2000
Cutting Tool Safety System	09/929,226 2002-0017183-A1 6,920,814	August 13, 2001 February 14, 2002 July 26, 2005
Cutting Tool Safety System	11/190,111	July 25, 2005
Cutting Tool Safety System	60/225,206	August 14, 2000
Table Saw With Improved Safety System	09/929,235 2002-0017184-A1	August 13, 2001 February 14, 2002
Table Saw With Improved Safety System	60/225,058	August 14, 2000
Miter Saw With Improved Safety System	09/929,238 2002-0017179-A1	August 13, 2001 February 14, 2002
Miter Saw With Improved Safety System	60/225,057	August 14, 2000
Fast Acting Safety Stop	60/157,340	October 1, 1999
Safety Systems For Power Equipment	09/676,190	September 29, 2000
Fast-Acting Safety Stop (Taiwan)	143466	February 25, 2002
Fast-Acting Safety Stop	60/182,866	February 16, 2000
Safety Systems for Power Equipment (PCT)	PCT/US00/26812	September 29, 2000
Miter Saw With Improved Safety System	10/052,806 2002-0059855-A1 6,880,440	January 16, 2002 May 23, 2002 April 19, 2005
Miter Saw With Improved Safety System	60/270,942	February 22, 2001

<u>Title</u>	<u>Serial No./ Publication No./ Patent No.</u>	<u>Filing Date/ Publication Date/ Issue Date</u>
Contact Detection System For Power Equipment	10/053,390 2002-0069734-A1	January 16, 2002 June 13, 2002
Contact Detection System For Power Equipment	60/270,011	February 20, 2001
Power Saw With Improved Safety System	10/052,273 2002-0059853-A1 6,813,983	January 16, 2002 May 23, 2002 November 9, 2004
Power Saw With Improved Safety System	60/270,941	February 22, 2001
Table Saw With Improved Safety System	10/052,705 2002-0056350-A1	January 16, 2002 May 16, 2002
Table Saw With Improved Safety System	60/273,177	March 2, 2001
Miter Saw With Improved Safety System	6,826,988 10/052,274 2002-0059854-A1	December 7, 2004 January 16, 2002 May 23, 2002
Miter Saw With Improved Safety System	60/273,178	March 2, 2001
Miter Saw With Improved Safety System	10/047,066 2002-0056348-A1	January 14, 2002 May 16, 2002
Miter Saw With Improved Safety System	60/275,594	March 13, 2001
Miter Saw With Improved Safety System	10/932,339	September 1, 2004
Safety Systems For Power Equipment	60/275,595	March 13, 2001
Miter Saw With Improved Safety System	10/051,782 2002-0066346-A1 6,877,410	January 15, 2002 June 6, 2002 April 12, 2005
Miter Saw With Improved Safety System	60/279,313	March 27, 2001
Safety Systems for Power Equipment	10/100,211 2002-0170399-A1	March 13, 2002 November 21, 2002
Safety Systems For Power Equipment	60/275,583	March 13, 2001
Translation Stop For Use In Power Equipment	09/955,418 2002-0020265-A1	September 17, 2001 February 21, 2002
Translation Stop For Use In Power Equipment	60/292,081	May 17, 2001

<u>Title</u>	<u>Serial No./ Publication No./ Patent No.</u>	<u>Filing Date/ Publication Date/ Issue Date</u>
Band Saw With Improved Safety System	10/146,527 2002-0170400-A1	May 15, 2002 November 21, 2002
Band Saw With Improved Safety System	60/292,100	May 17, 2001
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	10/172,553 2002-0190581-A1	June 13, 2002 December 19, 2002
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	60/298,207	June 13, 2001
Discrete Proximity Detection System	10/189,031 2003-0002942-A1	July 2, 2002 January 2, 2003
Discrete Proximity Detection System	60/302,937	July 2, 2001
Actuators for Use in Fast-Acting Safety Systems	10/189,027 2003-0005588-A1	July 2, 2002 January 9, 2003
Actuators For Use In Fast-Acting Safety Systems	60/302,916	July 3, 2001
Actuators For Use In Fast-Acting Safety Systems	10/205,164 2003-0020336-A1	July 25, 2002 January 30, 2003
Actuators For Use In Fast-Acting Safety Systems	60/307,756	July 25, 2001
Safety Systems For Power Equipment	10/785,361	February 23, 2004
Safety Systems For Power Equipment	60/312,141	August 13, 2001
Safety Systems For Band Saws	10/202,928 2003-0019341-A1	July 25, 2002 January 30, 2003
Safety Systems For Band Saws	60/308,492	July 27, 2001
Router With Improved Safety System	10/251,576 2003-0056853-A1	September 20, 2002 March 27, 2003
Router With Improved Safety System	60/323,975	September 21, 2001
Logic Control With Test Mode For Fast-Acting Safety System	10/243,042 2003-0058121-A1	September 13, 2002 March 27, 2003
Logic Control With Test Mode For Fast-Acting Safety System	60/324,729	September 24, 2001
Detection System for Power Equipment	10/292,607 2003-0090224-A1	November 12, 2002 May 15, 2003
Detection System For Power Equipment	60/335,970	November 13, 2001

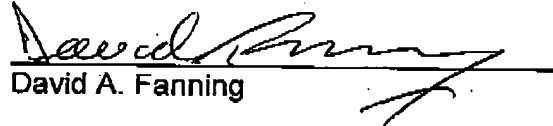
<u>Title</u>	<u>Serial No./ Publication No./ Patent No.</u>	<u>Filing Date/ Publication Date/ Issue Date</u>
Apparatus and Method for Detecting Dangerous Conditions In Power Equipment	10/345,630 2003-0131703-A1	January 15, 2003 July 17, 2003
Safety Systems For Power Equipment	60/349,989	January 16, 2002
Brake Pawls for Power Equipment	10/341,260 2003-0140749-A1	January 13, 2003 July 31, 2003
Brake Pawls For Power Equipment	60/351,797	January 25, 2002
Miter Saw With Improved Safety System	10/643,296 2004-0040426-A1	August 18, 2003 March 4, 2004
Miter Saw With Improved Safety System	60/406,138	August 27, 2002
Retraction System And Motor Position For Use With Safety Systems For Power Equipment	10/794,161	March 4, 2004
Retraction System And Motor Position For Use With Safety Systems For Power Equipment	60/452,159	March 5, 2003
Woodworking Machines With Overmolded Arbors	10/923,290 2005-0039822-A1	August 20, 2004 February 24, 2005
Table Saws With Safety Systems And Blade Retraction	60/496,550	August 20, 2003
Brake Cartridges for Power Equipment	10/923,273 2005-0039586-A1	August 20, 2004 February 24, 2005
Brake Cartridges For Power Equipment	60/496,574	August 20, 2003
Switch Box For Power Tools With Safety Systems	11/027,322 2005-0139459-A1	December 31, 2004 June 30, 2005
Switch Box For Power Tools With Safety Systems	60/533,598	December 31, 2003
Motion Detecting System for Use In A Safety System for Power Equipment	10/923,282 2005-0041359-A1	August 20, 2004 February 24, 2005
Motion Detection System For Use In A Safety System for Power Equipment	60/496,568	August 20, 2003
Detection Systems For Power Equipment	11/027,600 2005-0155473-A1	December 31, 2004 July 21, 2005
Improved Detection Systems For Power Equipment	60/533,791	December 31, 2003
Detection Systems For Power Equipment	11/107,499	April 15, 2005
Fences For Table Saws	11/027,254 2005-0139046-A1	December 31, 2004 June 30, 2005

<u>Title</u>	<u>Serial No./ Publication No./ Patent No.</u>	<u>Filing Date/ Publication Date/ Issue Date</u>
Improved Fence For Table Saws	60/533,852	December 31, 2003
Table Saws With Safety Systems	11/026,114 2005-0139057-A1	December 31, 2004 June 30, 2005
Improved Table Saws With Safety Systems	60/533,811	December 31, 2003
Brake Cartridges And Mounting Systems For Brake Cartridges	11/026,006 2005-0139058-A1	December 31, 2004 June 30, 2005
Brake Cartridges And Mounting Systems For Brake Cartridges	60/533,575	December 31, 2003
Table Saws With Safety Systems And Systems To Mount And Index Attachments	11/045,972	January 28, 2005
Improved Table Saws With Safety Systems And Systems To Mount And Index Attachments	60/540,377	January 29, 2004
Table Saw Throat Plates And Table Saws Including The Same	60/667,485	March 31, 2005
Miter Saw With Improved Safety System	11/098,984	April 4, 2005

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Date: August 23, 2005


David A. Fanning